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PATENT
Customer No. 22,852
Attorney Docket No. 06502.0342-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Manish KALBANDE et al.) Group Art Unit: 3692
)
Application No.: 09/867,645)
) Examiner: Harbeck, Timothy M.
Filed: May 31, 2001)
)
For: METHODS AND SYSTEMS FOR) Confirmation No. 7993
DELIVERY OF INFORMATION)
UPON ENROLLMENT IN AN)
INTERNET BILL PRESENTMENT)
AND PAYMENT ENVIRONMENT)

Attention: Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF UNDER BOARD RULE § 41.37

In support of the Notice of Appeal filed February 23, 2007, and further to 37 C.F.R. 41.37(a)(1), Appellants present this brief and encloses herewith a check for the fee of \$500.00 required under 37 C.F.R. 41.20(b)(2).

This Appeal responds to the final rejection of claims 1-29 mailed September 26, 2006 and to the Advisory Action mailed December 15, 2006.

If any additional fees are required or if the enclosed payment is insufficient, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

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I. Real Party in Interest

The real party in interest is Sun Microsystems, Inc., the assignee of record.

II. Related Appeals and Interferences

There are currently no other appeals or interferences, of which Appellants, Appellants' legal representative, or the assignee are aware, that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

In the Final Office Action mailed September 26, 2006, the Examiner rejected claims 8-10 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,578,015 to Haseltine et al. ("*Haseltine*"); rejected claims 1-7 and 14-20 under 35 U.S.C. § 103(a) as being unpatentable over *Haseltine* in view of PR Newswire, "Sun-Netscape Alliance's New Internet Billing Consolidation Application to Help Make Internet Billing a Reality for Consumers" ("*Newswire*"); and rejected claims 11-13 and 21-29 under 35 U.S.C. §103(a) as being unpatentable over *Haseltine*.

The final rejection of claims 1-29 is being appealed and a list of the claims on appeal is found in the attached Claims Appendix.

Furthermore, each claim of this patent application is separately patentable, and upon issuance of a patent will be entitled to a separate presumption of validity under 35 U.S.C. § 282.

IV. Status of Amendments

All amendments have been entered.

V. Summary of Claimed Subject Matter

The invention relates generally to a method and system that permits real-time delivery of customer profile and billing information in an Internet bill presentment and payment environment. The method and system minimizes the overhead incurred by the requesting Internet bill presentment and payment system and/or a biller by reducing the extent of biller-dependent modules, or modules that must be designed specially for each biller.

Independent claim 1 is directed to a bill presentment and payment environment with a scheduled time to communicate billing information with a set of billers. *See*, for example, specification at page 6, paragraph 012. The method includes receiving customer registration information, including information sufficient to identify the customer. *See*, for example, specification at pages 8-9, paragraph 024. The method also includes providing the customer identification information to one of the billers as part of a first request indicating enrollment in the bill presentment and payment system. *See*, for example, specification at page 9, paragraph 025. The method further includes permitting access by the customer to billing information from the one of the billers at an unscheduled time. *See*, for example, specification at pages 9-10, paragraph 026.

Dependent claim 2 states that the method also includes transmitting a second request to the one of the billers to access billing information, and receiving the billing information from the one of the billers. *See*, for example, specification at pages 9-10, paragraphs 025-026.

Independent claim 6 is directed to a bill presentment and payment environment with a scheduled time to communicate billing information with a requesting Internet bill

presentment and payment (IBPP) system. *See*, for example, specification at page 6, paragraph 013. The method includes receiving, from a requesting IBPP system, a request for information associated with a customer. *See*, for example, specification at page 9, paragraph 025. The method also includes retrieving the requested information. *See*, for example, specification at pages 9-10, paragraph 026. The method further includes forwarding the retrieved information to the requesting IBPP system at an unscheduled time. *See*, for example, specification at pages 9-10, paragraph 026.

Independent claim 8 is directed to a system for permitting real-time access by a customer to billing information in an Internet bill presentment and payment environment. *See*, for example, specification at pages 6-7, paragraph 014. The system includes a consolidator module and a biller module, connected to the consolidator module. *See*, for example, specification at pages 10-11, paragraph 028, and Fig. 1, ref. 120 and 130. The biller module includes biller-independent submodules for communicating with the consolidator module. *See*, for example, specification at pages 14-15, paragraph 038. The biller module also includes biller-dependent modules for retrieving information from data stored by the biller. *See*, for example, specification at pages 14-15, paragraph 038. The biller module further includes an interface enabling the biller-independent submodules to interact with the biller-dependent submodules. *See*, for example, specification a pages 14-15, paragraph 038, and Fig. 3B, ref. 366.

Dependent claim 9 states that the consolidator module also includes a bill presentment and payment module. *See*, for example, specification a page 12, paragraph 032, and Fig. 3A, ref. 312. The consolidator module also includes a client

object connected to the bill presentment and payment module. *See*, for example, specification a page 12, paragraph 032, and Fig. 3A, ref. 314.

Dependent claim 11 states that the biller module includes a server object, which receives a request from the consolidator module, a request handler, connected to the server object, and an implementation object which receives the request from the request handler. *See*, for example, specification a page 14, paragraph 036, and Fig. 3B, ref. 362, 364, 368.

Dependent claim 12 states that the biller-independent sub-modules include a server object, which receives a request from the consolidator module, a request handler, connected to the server object, and an implementation object which receives the request from the request handler. *See*, for example, specification a page 14, paragraph 036, and Fig. 3B, ref. 362, 364, 368.

Independent claim 14 is directed to a computer-readable medium including instructions for performing a method in a bill presentment and payment environment with a scheduled time to communicate billing information with a set of billers. *See*, for example, specification at page 6, paragraph 013. The method includes receiving customer registration information, including information sufficient to identify the customer. *See*, for example, specification at pages 8-9, paragraph 024. The method also includes providing the customer identification information to one of the billers as part of a first request indicating enrollment in the bill presentment and payment system. *See*, for example, specification at page 9, paragraph 025. The method further includes permitting access by the customer to billing information from the one of the billers at an unscheduled time. *See*, for example, specification at pages 9-10, paragraph 026.

Independent claim 19 is directed to a computer-readable medium including instructions for performing a method, when executed by a processor, in a bill presentment and payment environment with a scheduled time to communicate billing information with a requesting IBPP system. *See*, for example, specification at page 6, paragraph 013. The method includes receiving, from the requesting IBPP system, a request for information associated with a customer. *See*, for example, specification at page 9, paragraph 025. The method also includes retrieving the requested information. *See*, for example, specification at pages 9-10, paragraph 026. The method further includes forwarding the retrieved information to the requesting IBPP system at an unscheduled time. *See*, for example, specification at pages 9-10, paragraph 026.

Independent claim 21 is directed to a method of requesting information from a biller in a bill presentment and payment environment. *See*, for example, specification at page 6, paragraph 013. The method includes receiving customer registration information, including information sufficient to identify the customer. *See*, for example, specification at pages 8-9, paragraph 024. The method also includes providing the customer identification information to the biller as part of a request indicating enrollment in the bill presentment and payment system. *See*, for example, specification at page 9, paragraph 025. In addition, the request is provided to the biller in accordance with a bill data exchange protocol. *See*, for example, specification at pages 11-12, paragraphs 030-031, and pages 13-14, paragraph 035.

Independent claim 22 is directed to a method of providing billing data to a requesting IBPP system, in a bill presentment and payment environment. *See*, for example, specification at pages 6-7, paragraph 014. The method includes receiving a

request from the requesting IBPP system. *See*, for example, specification at page 9, paragraph 025. The method also includes retrieving the billing data based on the request. *See*, for example, specification at pages 9-10, paragraph 026. The method further includes providing the retrieved data to the requesting IBPP system. *See*, for example, specification at pages 9-10, paragraph 026. In addition, the retrieved data is provided to the requesting IBPP system in accordance with a bill data exchange protocol. *See*, for example, specification at pages 11-12, paragraphs 030-031, and pages 13-14, paragraph 035.

Independent claim 23 is directed to a real-time bill presentment and payment method in a bill presentment and payment environment. *See*, for example, specification at page 6, paragraph 012. The method comprises receiving customer registration information, including information sufficient to identify the customer. *See*, for example, specification at pages 8-9, paragraph 024. The method also comprises providing the customer identification information to one of the billers as part of a request indicating enrollment in the bill presentment and payment system. *See*, for example, specification at page 9, paragraph 025. The method further comprises permitting real-time access by the customer to billing information from the one of the billers. *See*, for example, specification at pages 9-10, paragraph 026.

Dependent claim 24 states that the method also includes transmitting a request to the one of the billers to access billing information, and receiving the billing information from the one of the billers. *See*, for example, specification at pages 9-10, paragraphs 025-026.

Independent claim 28 is directed to a method for providing billing information to a requesting IBPP system in real-time. See, for example, specification at pages 6-7, paragraph 014. The method includes receiving, from the requesting IBPP system, a request for information associated with a customer. See, for example, specification at page 9, paragraph 025. The method also includes retrieving the requested information. See, for example, specification at pages 9-10, paragraph 026. The method further includes forwarding the retrieved information to the requesting IBPP system in real-time. See, for example, specification at pages 9-10, paragraph 026.

VI. Grounds of Rejection

A. Claims 8-10 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,578,015 to Haseltine et al. ("*Haseltine*").

B. Claims 1-7 and 14-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Haseltine* in view of PR Newswire, "Sun-Netscape Alliance's New Internet Billing Consolidation Application to Help Make Internet Billing a Reality for Consumers" ("*Newswire*").

C. Claims 11-13 and 21-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Haseltine*.

VII. Argument

I. The rejection of claims 8-10 Under § 102(e) as being anticipated by *Haseltine* is improper

The Examiner's rejection of claims 8-10 under 35 U.S.C. §102(e) as being anticipated by *Haseltine* should be reversed.

To properly anticipate Appellants' claimed invention, the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See MPEP § 2121, *quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." MPEP § 2131. In this application, the Examiner has not demonstrated that each and every element of the claims are taught by *Haseltine*.

Claim 8 recites a system including:

a consolidator module; and
a biller module, connected to the consolidator module,
wherein the biller module includes
biller-independent submodules for communicating with the
consolidator module;
biller-dependent modules for retrieving information from data stored
by the biller; and
an interface enabling the biller-independent submodules to interact
with the biller-dependent submodules

(emphasis added). *Haseltine* does not disclose at least these elements of Appellants' claimed invention.

Haseltine discloses a network 300 “including billers, customers, consolidators and payment processors” (col. 9, lines 49-50). The Examiner states that thick consolidator 350 and thin consolidator 360 correspond to the claimed “consolidator module” and billers 310, 320, and 330 correspond to the claimed “biller module” (Final Office Action at page 2). The Examiner also asserts, “thick consolidators maintain databases of accounts related to the various billers” and “thin consolidators access information maintained at the biller sites” (Final Office Action at page 2). Even assuming that this is correct, which Appellants do not concede, the thick consolidators and thin consolidators do not constitute the claimed “biller-independent submodules” and “biller-dependent submodules” at least because these consolidators are part of the consolidator module, not the biller module, as stated by the Examiner and depicted in Fig. 3.

The Examiner also appears to consider thin consolidator access to information maintained at the biller sites of *Haseltine* as a teaching of the claimed “biller-dependent modules for retrieving information from data stored by the biller” (Office Action at page 2). This is not correct.

In *Haseltine*, the “thin consolidator may maintain a database similar to that shown at reference at 400 in FIG 4” (col. 10, lines 46-47). However, because the thin consolidator “typically carr(ies) only bill summaries,” it “refer(s) the customer to the biller’s own Web site for further detailed bills and/or further customer service, such as to discuss a disputed bill” (col. 2, lines 39-42). In “the case wherein the thin consolidator also maintains bill detail tables within its database, detailed bill data may also be available” (col. 10, line 66 to col. 11, line 1).

Thus, when the bill data requested by the customers is available within its database, the thin consolidator may retrieve the data from its own database and present it to the customers so that the customers can “view and/or pay” their “bills for one or more billers having contracted with the thin consolidator” (col. 10, lines 61-62). However, when the bill data requested by the customers is not available, the thin consolidator “refer(s) the customer to the biller’s own Web site for further detailed bills.” (col. 2, lines 39-41). To successfully refer the customer to the biller’s own Web site, “the thin consolidator may also maintain a customer-accessible link to” the biller’s Web site (col. 11, lines 2-3). The customers then directly connect to the biller’s Web site and obtain “detailed bill information independently of the thin consolidator” (col. 11, lines 11-15) (emphasis added). Nothing in *Haseltine* discloses a thin consolidator “for retrieving information from data stored by the biller,” as recited in claim 8.

Claim 1 recites a “biller module [that] includes . . . biller-dependent modules for retrieving information from data stored by the biller.” Thin consolidator 360 is not located within billers 310, 320, and 330 (See Fig. 3). Therefore, *Haseltine* does not teach or suggest “biller-dependent submodules for retrieving information from data stored by the biller” at least because any retrieval in *Haseltine* occurs by consolidators that are separate from the biller module. Therefore, *Haseltine* does not teach or suggest “biller-dependent modules for retrieving information from data stored by the biller; and an interface enabling the biller-independent submodules to interact with the biller-dependent submodules,” as further recited in claim 8.

Claim 9 depends from claim 8. As previously stated, *Haseltine* does not support the rejection of claim 8. Accordingly *Haseltine* also does not support the rejection of

claim 9 for at least the same reasons set forth above in connection with claim 8.

Further, *Haseltine* does not disclose “a client object, connected to the bill presentment and payment module,” as recited in claim 9.

The Examiner states, “*Haseltine* teaches objects in that a customer logs onto a web page to view and/or pay his or her bills” (Final Office Action at page 14). The Examiner cites col. 5, lines 15-23 and col. 10, lines 25-33 to teach the claimed “client object.” This is not correct.

Col. 5, lines 15-23 discloses bill format data 404 that may include HTML-formatted data “configured to mimic the ‘look-and-feel’ of the biller’s traditional paper bills.” Billers fonts, background color scheme, graphic designs, and/or layout may be reproduced. Col. 10, lines 25-33 discloses bill summary data and bill detail data may be available from the bill summary tables 432 and bill detail tables 434 when “the customer 370 logs onto the Web site of the thick consolidator.” Appellants find no teaching or suggestion in these passages of the claimed “client object.”

On the contrary, as stated in the Reply filed July 6, 2006, *Haseltine* discloses an embodiment of the invention “implemented as a database” (col. 4, lines 41-42). *Haseltine* further indicates that the invention is implemented as a relational database. For example, *Haseltine* specifically mentions that the data can be loaded into “a database (such as an Oracle Corp. database, for example), via mechanisms such as Oracle’s SQL*Loader utility or other Relational Database Management System (RDBMS) utilities” (col. 5, lines 33-36). *Haseltine* further discloses that “the partitioning process may be carried out according to the parameters set out, for example, in chapter 8 of *Oracle8 Server Concepts*, release 8.0© 1997 Oracle Corporation” (col. 5, line 67 -

col. 6, line 2). However, an Oracle database is a relational database, and *Haseltine* does not disclose embodiments implemented as other type of databases. Therefore, *Haseltine* does not teach or suggest the claimed “a client object, connected to the bill presentment and payment module,” as recited in claim 9.

For at least this additional reason, the cited art does not support the rejection of claim 9. Claim 10 depends from claim 9. As explained, *Haseltine* does not support the rejection of claim 9. Accordingly *Haseltine* also does not support the rejection of claim 10 for at least the same reasons set forth above in connection with claims 8 and 9. Accordingly, *Haseltine* cannot anticipate claims 8-10. Therefore, Appellants respectfully request that the Board reverse the rejection of claims 8-10 under 35 U.S.C. § 102(e).

II. The rejection of claims 1-7 and 14-20 under § 103(a) as being unpatentable over *Haseltine* in view of *Newswire* is improper

The Examiner’s rejection of claims 1-7 and 14-20 under 35 U.S.C. § 103(a) as being unpatentable over *Haseltine* in view of *Newswire* should be reversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among other things, neither *Haseltine* nor *Newswire*, taken alone or in combination, teach or

suggest each and every element recited by Appellants' claims. A *prima facie* case of obviousness has, therefore, not been established.

Claim 1 recites a method including:

providing the customer identification information to one of the billers as part of a first request indicating enrollment in the bill presentment and payment system; and

(emphasis added). *Haseltine* discloses two ways that the customers may register themselves to the bill presentment and payment database. "Customers wanting to view and pay bills may register themselves by accessing an HTML registration page" (col. 8, lines 65-66). "Alternatively, billers may supply the necessary customer information and enroll or register customers in a batch mode by loading the customer data into an interface provided in the staging area 420 over" http or ftp (col. 8, line 67 - col. 9, line 5). In both enrollment methods disclosed in *Haseltine*, the enrollment data collected or transmitted by the billers in the process is stored within the database. As a result, the customers log onto the system where the database is maintained. For example, in the case wherein the thick consolidator maintains the database, a "customer may log onto an Internet Web site maintained by the thick consolidator" (col. 10, lines 15-17). Because the customers log onto the system where the enrollment data is stored, the customer does not provide identification "information to one of the billers as part of a first request indicating enrollment."

The Examiner cites col. 9, lines 23-27 of *Haseltine* and states "that customers enroll in a system and that each customer has a unique user account including a plurality of biller accounts, one such biller account for each biller from whom the customer receives bills" (Final Office Action at page 14). Even though customer

accounts may correspond to the appropriate billers, there is no teaching in *Haseltine* of “providing the customer identification information to one of the billers as part of a first request.” On the contrary, any customer information in *Haseltine* is provided at an HTML registration page or staging area 420 as previously stated. The HTML registration page and staging area 420 are not present within the billers.

The Examiner also cites col. 11, lines 5-14 of *Haseltine* and states, “when further information is needed the consolidator uses a customer specific URL to the biller’s website” (Final Office Action at page 14). *Haseltine* discloses, “the thin consolidator 360 may also maintain a customer-accessible link to the billers 310, 320 to provide the customer 380 with detail bill data, customer service or other customer services” (emphasis added) (col. 11, lines 2-5). Col. 11, lines 5-14 of *Haseltine* provides an example of thin consolidator access to provide a customer with “detailed bill information.” Information is retrieved and provided to the customer. No information is provided to the biller.

Even assuming that URL connecting the customer and the biller facilitates sending identifying information from the consolidator to the biller, which Appellants do not concede, the URL provides the customer “with detailed bill information” (col. 11, lines 13-14). However, this detailed bill information only exists because the customer has previously enrolled. Therefore, even assuming that the act of sending information from the consolidator to the biller constitutes a request, which Appellants do not concede, *Haseltine* does not teach or suggest “providing the customer identification information to one of the billers as part of a first request indicating enrollment in the bill presentment and payment system,” as recited in claim 1.

The Examiner correctly notes that *Haseltine* does not teach “the step wherein the customer is permitted access to the billing information at an unscheduled time” (Final Office Action at page 4). However, the Examiner relies on *NewsWire* to teach this limitation.

Even if the Examiner’s reliance is appropriate, *NewsWire* does not cure the deficiencies of *Haseltine*. *NewsWire* discloses an internet bill presentment and payment solution. However, *NewsWire* does not teach or suggest “providing the customer identification information to one of the billers as part of a first request indicating enrollment in the bill presentment and payment system,” as recited in claim 1. Accordingly, *Haseltine* and *NewsWire* fail to establish a *prima facie* case of obviousness with respect to claim 1, at least because the references fail to teach each and every element of the claim.

Claims 2-5 depend from claim 1. As explained, the cited art does not support the rejection of claim 1 under 35 U.S.C. § 103(a). As such, the cited art does not support the rejection of claims 2-5 for at least the same reasons set forth in connection with the response to the rejection of claim 1. Further, *Haseltine* in view of *NewsWire* does not disclose or suggest the recitations of these dependent claims. For example, *Haseltine* or *NewsWire* does not teach or suggest “transmitting a second request to the one of the billers to access billing information,” as recited in claim 2.

The Examiner appears to assert that a URL linking a customer to a first biller constitutes a “first request,” and a URL linking a customer to a second biller constitutes a “second request” (Final Office Action at page 14). The Examiner position is incorrect for two reasons.

First, a customer accessible link in a form of URL merely provides the location information of the billers' Web site. Thus, when customers click the customer accessible link, the customers' browsers send HTTP requests directly to the billers' Web site using the location information from the link without any further participation or processing from the consolidator. Accordingly, maintaining the customer accessible link cannot constitute "transmitting a second request to the one of the billers to access billing information," as recited in claim 2.

Second, even assuming that the URL of *Haseltine* constitutes a request, which Appellants do not concede, there is only one URL, or request, for each biller, as stated by the Examiner (Final Office Action at page 14). Therefore, any "second request" in *Haseltine* would be a request for a different biller. In contrast, the "second request" in claim 2 is a "second request" to access billing information from the same biller that received the "first request." Therefore, because any second request in *Haseltine* links the customer to a second biller as stated by the Examiner, *Haseltine* does not teach or suggest "transmitting a second request to the one of the billers to access billing information," as recited in claim 2. For at least these additional reasons, the cited art does not support the rejection of claims 2-5 under 35 U.S.C. § 103(a).

Independent claim 14, though of different scope from claim 1, recites limitations similar to those set forth above with respect to claim 1. Claim 14 is therefore allowable for at least the reasons presented above. Claims 15-18 are also allowable at least due to their dependence from claim 14.

Claim 6 recites a method including:

receiving, from a requesting IBPP system, a request for information associated with a customer;

...

forwarding the retrieved information to the requesting IBPP system at an unscheduled time.

(emphasis added). The Examiner states, “the steps of logging on represents an implied request for information” is taught by *Haseltine* at column 10, lines 44-52 (Final Office Action at page 5). In *Haseltine*, the customers, not the IBPP systems, log onto the system. Therefore, even if the logging onto the system represents an implied request, which Appellants do not concede, the request is not from a IBPP system. Accordingly, *Haseltine* does not teach “receiving, from a IBPP system, a request for information associated with a customer,” as recited in claim 6.

The Examiner admits that *Haseltine* does not teach “wherein the retrieved information is forwarded at an unscheduled time” (Final Office Action at page 6). The Examiner, however, alleges, “[i]t would have been obvious to anyone skilled in the ordinary art at the time of invention to include the teachings of *Newswire* to the disclosure of *Haseltine* so that a customer can access their account information anytime they choose” (Final Office Action at page 6). Appellants respectfully disagree.

Newswire does not teach or suggest “forwarding the retrieved information to the requesting IBPP system at an unscheduled time,” as asserted by the Examiner.

Newswire discloses that the billers “can reach customers more than just once a month” (Page 2, paragraph 5). Instead of mailing a bill to a customer at a preset time (e.g. once a month), “the customer can log onto their online banking site to view a summary of bills from their service providers” (Page 2, paragraph 5).

The online banking site of *NewsWire* receives bills from the service providers once the billing period ends. When the bills are received, the banking site can post the bills for the customer to view as often as he would like. However, the fact that the bills can reach the customer more than once a month (i.e. allowing the customer to view the bill many times), does not mean that the online banking site receives the information at an unscheduled time. On the contrary, the information is received at the end of the billing cycle and can be viewed or paid by the customer at any time.

In *NewsWire*, bill information is forwarded to the online banking site at specific, scheduled time (end of the billing cycle), and the customer view and pay the bill at any time. Customer viewing and payment occurs independent from information forwarding to the banking site. Therefore, *NewsWire* does not teach or suggest “forwarding the retrieved information to the requesting IBPP system at an unscheduled time,” as recited in claim 6.

Accordingly, *Haseltine* and *NewsWire* fail to establish a *prima facie* case of obviousness with respect to claim 6, at least because the references fail to teach each and every element of the claim. Claim 7 depends from claim 6 and is thus also allowable for at least the same reasons as claim 6.

Independent claim 19, though of different scope from claim 6, recites limitations similar to those set forth above with respect to claim 6. Claim 19 is therefore allowable for at least the reasons presented above. Claim 20 is also allowable at least due to its dependence from claim 19. Therefore, Appellants respectfully request that the Board reverse the rejection of claims 1-7 and 14-20 under 35 U.S.C. § 103(a).

III. The rejection of claims 11-13 and 21-29 under § 103(a) as being unpatentable over *Haseltine* is improper

The Examiner's rejection of claims 11-13 and 21-29 under 35 U.S.C. § 103(a) as being unpatentable over *Haseltine* should be reversed. The prior art cited by the Examiner, *Haseltine*, does not teach or suggest each and every element of claims 11-13. A *prima facie* case of obviousness has, therefore, not been established.

Regarding the rejection of claim 11, the Examiner incorrectly asserts that *Haseltine* discloses "an example wherein the consolidator module request[s] information from the biller, the biller handles this request and further implements the request (Column 11, line 5-14). In this case, the consolidator is requesting account information for a particular customer that is maintained at the biller site" (Final Office Action at page 7). Appellants respectfully disagree with the Examiner's interpretation of the cited art.

The consolidators of *Haseltine* do not make requests to the billers in response to customers requests. Col 11, line 5-14 discloses, "thin consolidator 360 may maintain a customer-accessible link to the billers." However, as explained earlier, when the customers use the customer accessible link in the form of a URL, it is the customers that make direct requests to the billers. The Examiner states, "it is still the consolidator that does the linking. . . The communication, and therefore the request, is not made directly from customer to biller" (Final Office Action at page 15). This is not correct.

Haseltine explicitly states, "the thin consolidator may include a URL linking the customer 380 directly into a Web page containing the customer's 380 (detailed) billing data, thereby conveniently providing the customer 380 with detailed bill information

independently of the thin consolidator 360” (col. 11, lines 9-14) (emphasis added).

Therefore, the Examiner is incorrect in asserting that *Haseltine* discloses an example wherein the consolidator module requests information from the biller and that the consolidator is requesting account information for a particular customer that is maintained at the biller site.

Further, in rejecting claims 11 and 12, the Examiner correctly admits that *Haseltine* does not explicitly disclose “a server object, which receives a request from the consolidator module,” “a request handler, connected to the server object,” and “an implementation object which receives the request from the request handler” (Final Office Action at page 7). However, the Examiner incorrectly asserts that these system components would have been obvious in order to “execute the disclosed example, yielding a tangible result” (Final Office Action at page 7). As previously stated, *Haseltine* discloses a relational database, which does not implement objects.

Accordingly, nothing in *Haseltine* “suggests the desirability” of use of objects in the implementation to yield a tangible result, as asserted. Thus, there is no reason why one skilled in the art would look to use “a server object, which connected to the server object,” “a request handler, connected to the server object,” and “an implementation object which receives the request from the request handler” as asserted by the Examiner. Therefore, the conclusion in the Office Action was not reached based on facts gleaned from the cited reference. Instead, teachings of the present application were improperly used in hindsight to reconstruct the prior art. For at least these additional reasons, the Examiner has not established a *prima facie* case of obviousness with respect to claim 11-13.

Since the cited prior art fails to teach each and every element of claims 11-13, no *prima facie* case of obviousness, based on *Haseltine*, can be established for these claims.

Claim 21 recites a method including:

providing the customer identification information to the biller as part of a request indicating enrollment in the bill presentment and payment system,

(emphasis added). As previously stated, *Haseltine* discloses two ways that the customers may register themselves to the bill presentment and payment database. "Customers wanting to view and pay bills may register themselves by accessing an HTML registration page" (col. 8, lines 65-66). "Alternatively, billers may supply the necessary customer information and enroll or register customers in a batch mode by loading the customer data into an interface provided in the staging area 420 over" http or ftp (col. 8, line 67 - col. 9, line 5). In both enrollment methods disclosed in *Haseltine*, the enrollment data collected or transmitted by the billers in the process is stored within the database. As a result, the customers log onto the system where the database is maintained. For example, in the case wherein the thick consolidator maintains the database, a "customer may log onto an Internet Web site maintained by the thick consolidator" (col. 10, lines 15-17). Because the customers log on the system where the enrollment data is stored, the customer does not provide identification information to one of the billers as part of a first request indicating enrollment.

Haseltine discloses, "the thin consolidator 360 may also maintain a customer-accessible link to the billers 310, 320 to provide the customer 380 with detail bill data, customer service or other customer services" (emphasis added) (col. 11, lines 2-5).

Col. 11, lines 5-14 of *Haseltine* provide an example of thin consolidator access to provide a customer with “detailed bill information.” Information is retrieved and provided to the customer. No information is provided to the biller.

The Examiner cites col. 9, lines 23-27 of *Haseltine* and states “that customers enroll in a system and that each customer has a unique user account including a plurality of biller accounts, one such biller account for each biller from whom the customer receives bills” (Final Office Action at page 14). Even though customer accounts may correspond to the appropriate billers, there is no teaching in *Haseltine* of “providing the customer identification information to one of the billers as part of a first request.” On the contrary, any customer information in *Haseltine* is provided at an HTML registration page or staging area 420 as previously stated. The HTML registration page and staging area 420 are not present within the billers.

The Examiner also cites col. 11, lines 5-14 of *Haseltine* and states, “when further information is needed the consolidator uses a customer specific URL to the biller’s website” (Final Office Action at page 14). *Haseltine* discloses, “the thin consolidator 360 may also maintain a customer-accessible link to the billers 310, 320 to provide the customer 380 with detail bill data, customer service or other customer services” (emphasis added) (col. 11, lines 2-5). Col. 11, lines 5-14 of *Haseltine* provides an example of thin consolidator access to provide a customer with “detailed bill information.” Information is retrieved and provided to the customer. No information is provided to the biller.

Even assuming that URL connecting the customer and the biller facilitates sending identifying information from the consolidator to the biller, which Appellants do

not concede, the URL provides the customer “with detailed bill information” (col. 11, lines 13-14). However, this detailed bill information only exists because the customer has previously enrolled. Therefore, even assuming that the act of sending information from the consolidator to the biller constitutes a request, which Appellants do not concede, *Haseltine* does not teach or suggest “providing the customer identification information to the biller as part of a request indicating enrollment in the bill presentment and payment system,” as recited in claim 21. The rejection of claim 21 under 35 U.S.C. § 103(a) based on *Haseltine* is therefore improper.

Independent claim 23, though of different scope from claim 21, recites limitations similar to those set forth above with respect to claim 21. Claim 23 is therefore allowable for at least the reasons presented above. Claims 24-27 are also allowable at least due to their dependence from claim 23. Moreover, *Haseltine* does not disclose or suggest the elements of claim 24. Claim 24 recites elements similar to those of claim 2. As explained in the response to the Examiner’s rejection of claim 2, *Haseltine* does not disclose “transmitting a second request to the one of the billers to access billing information.” Also, *Haseltine* does not disclose “transmitting a request to the one of the billers to access billing information.” Therefore, no *prima facie* case of obviousness, based on *Haseltine*, can be established for these claims.

Claim 22 recites a method including:

receiving, from the requesting IBPP system, a request;
retrieving the billing data based on the request; and
providing the retrieved data to the requesting IBPP system . . .

(emphasis added). The Examiner cites col 10, lines 26-32 of *Haseltine* as a teaching of the claimed “retrieving” and “providing” (Office Action at pages 9-10). Any IBPP system

that may exist in *Haseltine* includes the Web site where the customer can view and pay bills and the thick consolidator 350, at least because the bills cannot be presented and paid without Web site interaction. Col. 10, lines 26-32 of *Haseltine* discloses the customer ability to view and pay bills on the Web site. As stated by the Examiner, the claimed "request" is implied by logging on (Final Office Action at page 9). However, logging on results in bills displayed on the Web site.

Any "receiving," "retrieving," and "providing" that may exist in the cited portions of *Haseltine* are located within the IBPP system. Any implied request is received by the IBPP system, which also displays the bills for viewing payment. Any "retrieving" and "providing" occurs at the Web site. Even assuming that the steps of "receiving," "retrieving," and "providing" are present, which Appellants do not concede, they occur within the IBPP system. Therefore, *Haseltine* does not teach or suggest "receiving, from the requesting IBPP system, a request" at least because any receiving in the cited portions of *Haseltine* occurs by the IBPP. Moreover, *Haseltine* does not teach or suggest "providing the retrieved data to the requesting IBPP system," as recited in claim 22, at least because any providing in the cited portions of *Haseltine* occurs by the IBPP, and the IBPP does not provide data to itself. The rejection of claim 22 under 35 U.S.C. § 103(a) based on *Haseltine* is therefore improper.

Independent claim 28, though of different scope from claim 22, recites limitations similar to those set forth above with respect to claim 22. Claim 28 is therefore allowable for at least the reasons presented above. Claim 29 is also allowable at least due to its dependence from claim 28. Therefore, Appellants respectfully request that the Board reverse the rejection of claims 11-13 and 21-29 under 35 U.S.C. § 103(a).

CONCLUSION

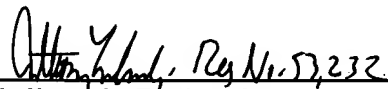
For at least the reasons given above, pending claims 1-29 are allowable over the applied prior art reference. Therefore, Appellants respectfully request the Board to reverse the Examiner's rejection of claims 1-29.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 23, 2007

By: 
for Jeffrey A. Berkowitz
Reg. No. 36,743

VIII. Claims Appendix to Appeal Brief Under Rule 41.37(c)(1)(viii)

1. In a bill presentment and payment environment with a scheduled time to communicate billing information with a set of billers, a bill presentment and payment method comprising:

receiving customer registration information, including information sufficient to identify the customer;

providing the customer identification information to one of the billers as part of a first request indicating enrollment in the bill presentment and payment system; and

permitting access by the customer to billing information from the one of the billers at an unscheduled time.

2. The method of claim 1, wherein permitting access by the customer to billing information comprises:

transmitting a second request to the one of the billers to access billing information; and

receiving the billing information from the one of the billers.

3. The method of claim 1, wherein the first request is independent of the biller.

4. The method of claim 1, wherein the billing information includes at least one of a customer profile or billing data associated with the customer.

5. The method of claim 1, wherein the customer identification information includes one or more of name, address, phone number, e-mail address, social security number, date of birth, or account number.

6. In a bill presentment and payment environment with a scheduled time to communicate billing information with a requesting Internet bill presentment and payment (IBPP) system, a method for providing billing information comprising:

receiving, from a requesting IBPP system, a request for information associated with a customer;

retrieving the requested information; and

forwarding the retrieved information to the requesting IBPP system at an unscheduled time.

7. The method of claim 6, wherein the step of forwarding the retrieved information comprises the steps of:

transforming the retrieved information to a format accepted by the requesting IBPP system; and

forwarding the transformed information to the requesting IBPP system.

8. A system for permitting real-time access by a customer to billing information in an Internet bill presentment and payment environment, the system comprising:

a consolidator module; and

a biller module, connected to the consolidator module,

wherein the biller module includes

- biller-independent submodules for communicating with the consolidator module;
- biller-dependent modules for retrieving information from data stored by the biller; and
- an interface enabling the biller-independent submodules to interact with the biller-dependent submodules.

9. The system of claim 8 wherein the consolidator module includes:
- a bill presentment and payment module; and
 - a client object, connected to the bill presentment and payment module.
10. The system of claim 9, wherein the bill presentment and payment module provides an interface for accepting registration and requests from the customer.

11. The system of claim 8, wherein the biller module includes:
- a server object, which receives a request from the consolidator module;
 - a request handler, connected to the server object; and
 - an implementation object which receives the request from the request handler.

12. The system of claim 8, wherein the biller-independent sub-modules include:
- a server object, which receives a request from the consolidator module;
 - a request handler, connected to the server object; and

an implementation object which receives the request from the request handler.

13. The system of claim 12, wherein the implementation object is configured to implement the interface, based on information included in the request.

14. A computer-readable medium including instructions for performing a method in a bill presentment and payment environment with a scheduled time to communicate billing information with a set of billers, when executed by a processor, the bill presentment and payment method comprising:

receiving customer registration information, including information sufficient to identify the customer;

providing the customer identification information to one of the billers as part of a first request indicating enrollment in the bill presentment and payment system; and

permitting access by the customer to billing information from the one of the billers at an unscheduled time.

15. The computer-readable medium of claim 14, wherein the step of permitting access by the customer to billing information comprises:

transmitting a second request to the one of the billers to access billing information; and

receiving the billing information from the one of the billers.

16. The computer-readable medium of claim 14, wherein the first request is independent of the biller.

17. The computer-readable medium of claim 14, wherein the billing information includes at least one of a customer profile or billing data associated with the customer.

18. The computer-readable medium of claim 14, wherein the customer identification information includes one or more of name, address, phone number, e-mail address, social security number, date of birth, or account number.

19. A computer-readable medium including instructions for performing a method, when executed by a processor, in a bill presentment and payment environment with a scheduled time to communicate billing information with a requesting IBPP system, for providing billing information, the method comprising comprising:

receiving, from the requesting IBPP system, a request for information associated with a customer;

retrieving the requested information; and

forwarding the retrieved information to the requesting IBPP system at an unscheduled time.

20. The computer-readable medium of claim 19, wherein the step of forwarding the retrieved information comprises the steps of:

transforming the retrieved information to a format accepted by the requesting IBPP system; and

forwarding the transformed information to the requesting IBPP system.

21. In a bill presentment and payment environment, a method of requesting information from a biller comprising:

receiving customer registration information, including information sufficient to identify the customer; and

providing the customer identification information to the biller as part of a request indicating enrollment in the bill presentment and payment system,

wherein the request is provided to the biller in accordance with a bill data exchange protocol.

22. In a bill presentment and payment environment, a method of providing billing data to a requesting IBPP system, the method comprising:

receiving, from the requesting IBPP system, a request;

retrieving the billing data based on the request; and

providing the retrieved data to the requesting IBPP system,

wherein the retrieved data is provided to the requesting IBPP system in accordance with a bill data exchange protocol.

23. In a bill presentment and payment environment with a set of billers, a real-time bill presentment and payment method comprising:

receiving customer registration information, including information sufficient to identify the customer;

providing the customer identification information to one of the billers as part of a request indicating enrollment in the bill presentment and payment system; and

permitting real-time access by the customer to billing information from the one of the billers.

24. The method of claim 23, wherein permitting access by the customer to billing information comprises:

transmitting a request to the one of the billers to access billing information; and
receiving the billing information from the one of the billers.

25. The method of claim 23, wherein the request is independent of the biller.

26. The method of claim 23, wherein the billing information includes at least one of a customer profile or billing data associated with the customer.

27. The method of claim 23, wherein the customer identification information includes one or more of name, address, phone number, e-mail address, social security number, date of birth, or account number.

28. In a bill presentment and payment environment, a method for providing billing information to a requesting IBPP system in real-time, the method comprising:

receiving, from the requesting IBPP system, a request for information associated with a customer;

retrieving the requested information; and

forwarding the retrieved information to the requesting IBPP system in real-time.

29. The method of claim 28, wherein the step of forwarding the retrieved information comprises the steps of:

transforming the retrieved information to a format accepted by the requesting IBPP system; and

forwarding the transformed information to the requesting IBPP system.

IX. Evidence Appendix to Appeal Brief Under Rule 41.37(c)(1)(ix)

None.

X. Related Proceedings Appendix to Appeal Brief Under Rule 41.37(c)(1)(x)

None.